

REMARKS

By this amendment, claims 1, 4 and 5 are revised to place this application in condition for allowance. Currently, claims 1-18 are before the Examiner for consideration on their merits.

Turning now to the prior art rejection, the Examiner maintains the rejection in terms of relying on the Kemp and Crosby prior art references. Claims 1-7 stand rejected under 35 U.S.C. § 102(e) based on Kemp, while claim 1 is rejected under 35 U.S.C. § 102(b) based on Crosby. Claim 2 is now rejected under 35 U.S.C. § 103(a) based on Crosby.

Claims 8-10, 17, and 18 are rejected based on the combination of Crosby and United States Patent No. 5,773,020 to Place et al (Place).

In response to Applicant's last amendment, the Examiner further explained the reasoning for the rejection on page 2 of the Detailed Action. Therein, the Examiner indicated that she can give the claims their broadest reasonable interpretation. In doing so, it is Applicant's understanding that the Examiner has taken the position that claim 1 can be interpreted as presenting two conditions A or B. Condition A only requires that the vasodilator active compound is disposed on the external condom surface in a form, with condition B requiring that the vasodilator active compound is disposed on the external condom surface in a composition that is immiscible with the lubricant. Put another way, the Examiner is interpreting claim 1 to only require the immiscibility limitation to apply to the B condition not both of the A and B conditions. In doing so, the Examiner can then take the position that the prior art that teaches the use of a vasodilator compound in a form reads on claim 1.

While Applicant believes that this is not a proper interpretation of the claim when

reading the specification and understanding the invention, claim 1 has been revised to make it clear that the immiscibility limitation applies to both the vasodilator active compound when disposed on the external condom surface in a form and when the vasodilator active compound is disposed on the external condom surface in a composition. No new matter is introduced by this amendment, since the specification clearly teaches the scenario now claimed; it is the very invention of Applicant.

As previously argued, the issue in this application is the limitation regarding the immiscibility of the vasodilator active compound and the lubricant. It is respectfully requested that the prior art does not teach this limitation as now recited in claim 1, and the rejections based on 35 U.S.C. § 102 must be withdrawn.

In the rejections based on 35 U.S.C. § 102, the Examiner makes no mention of whether Kemp or Crosby teach the immiscibility aspect of the invention. It is contended that the reason for this silence is that neither of these references teaches what is now defined in claim 1. The previous arguments are also incorporated by reference regarding the failure of the prior art to teach the immiscibility aspect of the invention. The Examiner is called upon to support any further rejection of the claims with citation to page and line number for the support of a contention that the claim limitation in question is either expressly or implicitly disclosed.

Since Kemp and Crosby cannot anticipate claim 1, the only recourse for the Examiner is to reject claim 1 under 35 U.S.C. § 103(a). However, in order to make such a rejection, the Examiner would have to both allege that it would be obvious to make the vasodilator compound used in Kemp and Crosby in a form or in a composition, both of which being immiscible with the lubricant. The Examiner cannot make such an allegation since, absent the teachings of Applicant; there is no reason to make such a change.

Consequently, any rejection based on 35 U.S.C. § 103(a) could not be sustained on appeal.

In view of the fact that the prior art does not teach each and every limitation of claim 1 and lacks any teaching to support an obvious contention, the Examiner must withdraw the rejection of claim 1. Furthermore, since the remaining dependent claims are all dependent on claim 1, all claims are now in condition for allowance.

Accordingly, the Examiner is respectfully requested to examine this application in light of this Amendment and pass claims 1-18 onto issuance.

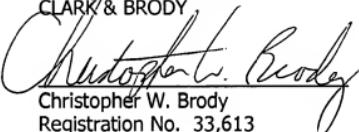
If the Examiner believes that another interview with Applicant's attorney would be helpful in expediting allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated March 13, 2006.

Again, reconsideration and allowance of this application is respectfully requested.

Please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
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